

JAN 22 2007

Attorney Docket No. AOL0149

U.S. Serial No. 10/719,483

REMARKS

By this paper, claim 1 was amended to correct a typographical error. No other amendments were made. Presently, the application contains claims 1-32. Applicant requests favorable reconsideration and allowance of all claims in the application for the reasons stated below.

35 USC 103 REJECTIONS:
CLAIMS 1-5, 7-12, 14-19, 21-26, 28-32

These claims were rejected under 35 USC 103 as being unpatentable over the combination of U.S. Patent Document 2002/0156685 to Ehrlich et al. ("Ehrlich") in view of U.S. Patent Document 6,546,388 to Edlund et al. ("Edlund"). This rejection is respectfully traversed. The claims are patentable since a *prima facie* case of obviousness has not been established, as discussed in greater detail below.¹

Teaching/Suggestion of Claim Limitations

Introduction

First, the *prima facie* obviousness case is incomplete because, even if the references were to be combined as suggested (albeit improperly, as discussed below), the combination still does not teach or suggest all the claim limitations.²

To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.³

All words in a claim must be considered in judging the patentability of that

¹ MPEP 2142.

² MPEP 2142, 2143.03.

³ Ex Parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). MPEP 706.02(j).

Attorney Docket No. AOL0149

U.S. Serial No. 10/719,483

claim against the prior art.⁴Claim 1

Taking claim 1 as an example, the proposed combination of references fails to teach the following combination:

" A search method, comprising the operations of:
a browser receiving a user's query and submitting the query to a search engine;
the browser receiving from the search engine a results list of at least one item of search results arising from the query where each said item is associated with at least one site, the browser further displaying the results list;
the browser providing a selection mechanism programmed to receive user input identifying one or more items of search results from among the displayed results list;
responsive to the browser receiving user input via the selection mechanism, the browser preparing a search cart list including the identified items of search results;
the browser displaying the search cart list and providing the user with access to sites associated with the identified items of search results directly from the displayed search cart list without the user having to operate the browser to navigate back to the displayed results list and select an item of search results therefrom."

As a more particular example, claim 1 is patentably distinguishable from the applied art because the applied art does not show the claimed combination including **"the browser receiving from the search engine a results list of at least one item of search results arising from the query where each said item is associated with at least one site, the browser further displaying the results list."**

Erlich has nothing to do with search engines. In fact, while describing its own invention (beginning with para. 0048), Erlich fails to include any meaningful use of "search engine." In fact, outside Erlich's background, "search engine" is only used once, in a generalized definitions section in paragraphs 0049-0064. Erlich's drawings fail to show a search engine.

⁴ In re Wilson, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). MPEP 2143.03.

Attorney Docket No. AOL0149

U.S. Serial No. 10/719,483

Nevertheless, the office action argued that Erlich teaches this feature at paragraph 0005. [Office Action: page 2] The office action's argument is not persuasive. The cited passage is actually distinct from Erlich's invention. Namely, para. 0005 constitutes Erlich's discussion of the prior art approaches. [See heading "Background of the Invention" between paragraphs 0002 and 0003] The office action failed to propose and further to support the combined teaching of Erlich and Erlich's cited prior art. It would be improper for the office action to pick and choose aspects of the Erlich's invention and other unrelated inventions, with the aid of hindsight reconstruction, and apply them as a single prior art reference.

This situation is better illustrated using a hypothetical example. In a hypothetical patent, the patentee describes his invention, a turbojet engine. As background to his patent, the patentee describes various early aircraft power schemes including the first ornithopter (a machine that flies by flapping wings), constructed by Gustave Trouvé in 1870. Using the logic of the present office action, it would be proper to construct a rejection applying the features of the patentee's jet engine and features of Trouvé's ornithopter simply because their description occurred in the same reference, even though neither the patentee nor anyone else ever conceived of combining the two.

For these reasons, the use of paragraph 0005 in the office action is improper.

Moreover, Erlich's disclosure clearly distances itself from paragraph 0005 and other teachings of the background art. Along these lines, Erlich teaches away from these approaches, characterizing them as inaccurate, inconvenient, and difficult. [Erlich: paras. 0016-0017] Erlich suggests that the state of the art does not adequately address shoppers' needs. [Erlich: para. 0020] In this regard, Erlich proposes that customers should be able to browse any store, at any time, and be able to choose an item for a virtual shopping cart and have any information available to that potential purchase retained for subsequent purchasing decisions, regardless of when that decision is made. [Erlich: para. 0021] It is no surprise that, in subsequent paragraphs, Erlich's disclosure of its

Attorney Docket No. AOL0149

U.S. Serial No. 10/719,483

own invention proposes an entirely different structure that does not include any search engines.

Claim 1, then, is distinguished from Erlich, as Erlich's own words show that Erlich has nothing to do with the claimed feature "the browser receiving from the search engine a results list of at least one item of search results arising from the query where each said item is associated with at least one site, the browser further displaying the results list."

Claim 1 is further distinguished from the applied art because the applied art does not show the claimed combination including **"the browser providing a selection mechanism programmed to receive user input identifying one or more items of search results from among the displayed results list."** Erlich cannot possibly describe the claimed feature because Erlich does not show the claimed "results list" (received from a search engine) as discussed above.

The office action argued that Erlich teaches the foregoing feature in paragraphs 0017-0018. The office action's argument is not persuasive. Erlich's paragraphs 0018-0018 occur in Erlich's description of background art. For the same reasons discussed above, Applicant traverses the combination of Erlich and Erlich's prior art implicit to this rejection.

Claim 1 is further distinguished from the applied art because there is no teaching of **"responsive to the browser receiving user input via the selection mechanism, the browser preparing a search cart list including the identified items of search results."** The office action argued that this feature is found in Erlich's paragraph 0018. This argument is not persuasive. First, Applicant traverses the use of paragraph 0018 (from Erlich's background description) for the same reasons stated above. Second, Erlich's paragraph 0018 fails to mention search results (from a search engine), and further fails to describe any action performed by a browser, as claimed.

Turning the discussion from Erlich's background to the description of Erlich's described embodiments, Erlich's own words make it clear that Erlich is unrelated to any actions performed by a browser. In this regard, outside its background and definitions sections, Erlich only mentions a "browser" once (in

Attorney Docket No. AOL0149

U.S. Serial No. 10/719,483

para. 0080), in a context unrelated to the subject claim feature. Indeed, Erlich's work is done by a central shopping cart manager 95, shopping cart engine 125, and other components of a virtual shopping cart system 10 that are sited in a host server 15 centrally located and clearly distinct from any web browsers of remote shoppers. [Erlich: Fig. 3A, ref. 335, 340; Fig. 1, ref. 15, 35, 37, 39; para. 0065]

Accordingly, Erlich fails to teach the claimed operation "responsive to the browser receiving user input via the selection mechanism, the browser preparing a search cart list including the identified items of search results."

Claim 1 is further distinguished from the applied art because there is no teaching of **"the browser displaying the search cart list and providing the user with access to sites associated with the identified items of search results directly from the displayed search cart list without the user having to operate the browser to navigate back to the displayed results list and select an item of search results therefrom."** The office action argued that this feature is found in Erlich's paragraphs 0002, 0017, 0027. This argument is not persuasive. Erlich's para. 0002 describes the Field of Invention, but fails to teach any meaningful details related to the claimed feature. Erlich's para. 0017 comes from its background description, and for this reason Applicant traverses its use for the same reasons discussed above. Erlich's para. 0027, by its own words, distinctly teach away from the claimed feature. Indeed, Erlich says the its invention "enables the sale consummation directly from the shopping cart without having to visit the merchant's web sites." Thus, it cannot be said that Erlich provides the user with access to the sites directly from the cart - - indeed, Erlich does the opposite ("... without having to visit the merchant's web sites.") [Erlich: para. 0027]

Thus, Erlich fails to teach the claimed operation of "the browser displaying the search cart list and providing the user with access to sites associated with the identified items of search results directly from the displayed search cart list without the user having to operate the browser to navigate back to the displayed results list and select an item of search results therefrom."

Attorney Docket No. AOL0149

U.S. Serial No. 10/719,483

In view of the foregoing, the features of claim 1 are not taught by the applied art.

Claim 30

In addition to the same reasons expressed above, independent claim 30 is distinguished over the proposed Erlich/Edlund combination for certain additional reasons.

First, the applied art does not teach an "enhanced search method operable in an environment where a browser receives a user's query and submits the query to a search engine, and the browser receives from the search engine a results list of at least one item of search results arising from the query, where each said item is associated with at least one site, and the browser further displays the results list" as claimed.

The office action did not address this claim language, electing instead to group its discussion of claim 30 with the discussion of claim 1. [Office Action: page 2] However, claims 1 and 30 utilize different claim language. Without more, the *prima facie* case of obviousness is incomplete as to claim 30.

Moreover, as explained above in detail, Erlich directly teaches away from the claimed "enhanced search method operable in an environment where a browser receives a user's query and submits the query to a search engine, and the browser receives from the search engine a results list of at least one item of search results arising from the query, where each said item is associated with at least one site, and the browser further displays the results list."

Accordingly, claim 30 is *a fortiori* patentable for these additional reasons.

Claim 31

In addition to the same reasons expressed above, independent claim 30 is distinguished over the proposed Erlich/Edlund combination for certain additional reasons.

The office action contends that Erlich teaches a "method for enhancing operation of a computer-implemented browser..." including an operation of

Attorney Docket No. AOL0149

U.S. Serial No. 10/719,483

"modifying the browser..." [Office Action: page 9] The office action points to Erlich's paragraph 0115 in support of its contention. Para. 0115, however, merely contains boilerplate language stating that "numerous modifications may be made... without departing from the spirit..." [Erlich: para. 0115] There is nothing in para. 0115 to suggest or support enhancing a computer-implemented browser. In this sense, Erlich's para. 0115 fails to qualify as an enabling 35 USC 103 reference. A reference itself must sufficiently describe the claimed invention to have placed the public in possession of it.⁵ Even if a claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it was not enabling.⁶ In order to anticipate, a prior art reference must be enabling, thus placing the allegedly disclosed subject matter in the possession of the public.⁷ The reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of invention in possession of it.⁸ Erlich's boilerplate language fails to provide any meaningful disclosure pertaining to the claim language, and therefore fails as an enabling 35 USC 103 reference.

Importantly, a careful reading of the non-boilerplate text in the remainder of Erlich reveals that Erlich sharply teaches away from the claim language. First, Erlich's disclosure does not meaningfully involve a browser. In this regard, outside its background and definitions sections, Erlich only mentions a "browser" once (in para. 0080), in a context unrelated to the subject claim feature. Indeed, Erlich's work is done by a central shopping cart manager 95, shopping cart engine 125, and other components of a virtual shopping cart system 10 that are sited in a host server 15 centrally located and clearly distinct from any web

5 Paperless Accounting, Inc. v. Bay Area Rapid Transit System, 231 USPQ 649, 653 (Fed. Cir. 1986). Ex parte Gould, 231 USPQ 421 (CCPA 1973).

6 *Id.*

7 Akzo N.V. v. United States ITC, 808 F.2d 1471, 1 USPQ2d 1241 (Fed. Cir. 1986); Ashland Oil, Inc. v. Delta Resins & Refracs., Inc., 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985); Reading & Bates Constr. Co. v. Baker Energy Res. Corp., 748 F.2d 645, 223 USPQ 1168 (Fed. Cir. 1984)

8 In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990).

Attorney Docket No. AOL0149

U.S. Serial No. 10/719,483

browsers of remote shoppers. [Erich: Fig. 3A, ref. 335, 340; Fig. 1, ref. 15, 35, 37, 39; para. 0065]

Therefore, as Erlich utilizes programming features central to many users instead of the fundamentally different approach of modifying users' web browsers, Erlich actually teaches away from a "method for enhancing operation of a computer-implemented browser..." including an operation of "modifying the browser..."

Accordingly, claim 31 is a *fortiori* distinguished from the applied art.

Claims 2-5, 7-12, 14, 15-19, 21-26, 28-29

For similar reasons as stated above, independent claims 15 and 29 are absent from the applied art. And, even without considering any individual merits of claims 2-5, 7-12, 14, 16-19, 21-26, and 28, these claims are distinguished from the applied art because they depend from independent claims that are distinguished as discussed above.⁹

Suggestion or Motivation

In addition to the reasons given above, the *prima facie* obviousness case is also incomplete because there has been no suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.¹⁰

The office action argues that it would have been obvious to an ordinarily skilled artisan to combine Erlich and Edlund because "a browser receiving a user's query and submitting the query to a search engine, would enable the search method to 'present to an end-user the intermediate matching search results of a keyword search in an index list of information. The method

⁹ If an independent claim is nonobvious under 35 USC 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). MPEP 2143.03.

¹⁰ MPEP 2142.

Attorney Docket No. AOL0149

U.S. Serial No. 10/719,483

comprising the steps of: coupling to a search engine a graphical user interface for accepting keyword search terms for searching an indexed list of information with a search engine." [Office Action: pages 3-4]

In other words, the Examiner has proposed to add Edlund's feature ("coupling to a search engine a graphical user interface for accepting keyword search terms..." from Edlund's Abstract) to Erlich for the following reason: to enable Erlich to conduct the following activity ("presenting to an end-user the intermediate matching search results of a keyword search in an index list of information...." from Edlund's Abstract).

The argument for combining the references is unpersuasive for a number of reasons.

1. **First, the proposed Erlich/Edlund combination is improper because the references teach away from this combination.** Erlich's disclosure clearly distances itself from previous approaches using search engines, characterizing them as inaccurate, inconvenient, and difficult. [Erlich: paras. 0016-0017] Erlich suggests that the state of the art does not adequately address shoppers' needs. [Erlich: para. 0020] In this regard, Erlich proposes that customers should be able to browse any store, at any time, and be able to choose an item for a virtual shopping cart and have any information available to that potential purchase retained for subsequent purchasing decisions, regardless of when that decision is made. [Erlich: para. 0021]

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.¹¹

Furthermore, it is improper to combine references where the references teach away from their combination.¹²

As Erlich teaches away from the proposed Erlich/Edlund combination, claim 1 is patentable because the required suggestion or motivation to combine

¹¹ W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). MPEP 2141.02.

¹² In re Graselli, 713 F.2d 731, 218 USPQ 769, 779 (Fed. Cir. 1983). MPEP 2145(4).

Attorney Docket No. AOL0149

U.S. Serial No. 10/719,483

references is lacking.

2. Second, the proposed Erlich/Edlund combination is improper because it would change Erlich's principle of operation.¹³ As discussed above, Erlich distances itself from prior approaches that use search engines. It is no surprise that, in subsequent paragraphs, Erlich's disclosure of its own invention proposes an entirely different structure that does not include any search engines. Indeed, Erlich employs a central shopping cart manager 95, shopping cart engine 125, and other components of a virtual shopping cart system 10 that are sited in a host server 15 centrally located and clearly distinct from any web browsers of remote shoppers. [Erlich: Fig. 3A, ref. 335, 340; Fig. 1, ref. 15, 35, 37, 39; para. 0065] Modifying Erlich to use Edlund's search engine approach would completely change the Erlich's principle of operation, requiring a substantial redesign and reconstruction of Erlich's elements.¹⁴

For these reasons, the *prima facie* case of obviousness is incomplete and claim 1 is patentable.

3. Third, in the absence of hindsight reconstruction, the rationale for combining Erlich with Edlund does not make sense. The Examiner has proposed to add Edlund's feature ("coupling to a search engine a graphical user interface for accepting keyword search terms..." from Edlund's Abstract) to Erlich. The rationale was to enable Erlich to conduct the following activity ("presenting to an end-user the intermediate matching search results of a keyword search in an index list of information...." from Edlund's Abstract). [Office Action: pages 3-4]

Despite the extraction of various quotes from Edlund's Abstract in the foregoing proposed motivation to combine Erlich/Edlund, the end product does not contain any meaningful explanation of why it would benefit Erlich to present

¹³ In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). MPEP 2143.01.

¹⁴ MPEP 2143.01.

Attorney Docket No. AOL0149

U.S. Serial No. 10/719,483

to an end-user the intermediate matching search results of a keyword search. There has been no reasoning, in easy-to-understand terms, of any a real benefit. Further, the proposed benefit itself (Edlund's "intermediate matching search results") is vague, since Edlund only mentions it twice— in the Abstract and Summary. Edlund's specification or drawings contain no meaningful disclosure of this term.

Rather, it seems that the office action has cherry-picked features from Edlund's Abstract for addition to Erlich simply to make up for deficiencies in Erlich's disclosure. With nothing more, it appears that the Erlich/Edlund combination is simply a result of hindsight reconstruction. However, it is improper to attempt to establish obviousness by using the applicant's specification as a guide to combining different prior art references to achieve the results of the claimed invention.¹⁵ The teaching or suggestion to make the claimed combination must be found in the prior art, and not based on applicant's disclosure.¹⁶ The critical inquiry is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.¹⁷ Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art."¹⁸ But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the

¹⁵ Orthopedic Equipment Co., Inc. v. United States, 702 F.2d 1005, 1012, 217 USPQ 193, 199 (Fed. Cir. 1983).

¹⁶ In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

¹⁷ In re Fritch, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992) ("It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious."); *Fromson v. Advance Offset Plate, Inc.*, 755 F.2d 1549, 1556, 225 USPQ 26, 31 (Fed. Cir. 1985) (nothing of record plainly indicated that it would have been obvious to combine previously separate lithography steps into one process). See e.g., *In re Gordon et al.*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (mere fact that prior art could be modified by turning apparatus upside down does not make modification obvious unless prior art suggests desirability of modification); *Ex Parte Kaiser*, 194 USPQ 47, 48 (Pat. Bd. of App. 1975) (Examiner's failure to indicate anywhere in the record his reason for finding alteration of reference to be obvious militates against rejection).

¹⁸ In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

Attorney Docket No. AOL0149

U.S. Serial No. 10/719,483

combination."¹⁹ And "teachings of references can be combined only if there is some suggestion of incentive to do so."²⁰

"To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher."²¹ It is essential that "the decisionmaker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made. . . to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art."²²

The policy of the Patent and Trademark Office²³ is to follow in each and every case the standard of patentability enunciated by the Supreme Court in *Graham v. John Deere Co.*²⁴ As stated by the Supreme Court:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or non-obviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.²⁵

19 ACS Hosp. Sys. Inc. v. Montefiore Hosp., 32 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

20 *Id.*

21 W. L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

22 *Id.*

23 MPEP 2141.

24 148 USPQ 459 (1966).

25 148 USPQ at 467.

Attorney Docket No. AOL0149

U.S. Serial No. 10/719,483

Thus, hindsight reconstruction, using the applicant's specification itself as a guide, is improper because it fails to consider the subject matter of the invention "as a whole" and fails to consider the invention as of the date at which the invention was made.

For these reasons, the *prima facie* case of obviousness is incomplete and claim 1 is patentable.

Reasonable Expectation of Success

In addition to the reasons stated above, the *prima facie* obviousness case is further defective because the office action failed to show that there would be a reasonable expectation of success in modifying/combining references.²⁶ The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.²⁷ If the examiner does not produce a *prima facie* case, the applicant is under *no* obligation to submit evidence of nonobviousness.²⁸

Critically, to establish a *prima facie* case of obviousness, there must be a reasonable expectation of success.²⁹ This reasonable expectation of success must be found in the prior art, not in Applicant's disclosure.³⁰

The office action lacks any evidence, allegation, or other mention of the legally required "reasonable expectation of success." Since this mandatory topic is unaddressed by the office action, no *prima facie* case of obviousness has been properly established.

Furthermore, an ordinarily skilled artisan would not enjoy reasonable prospects of success in combining Erlich with Edlund. As explained above in

²⁶ MPEP 2142, 2143.02.

²⁷ MPEP 2142.

²⁸ *Id.*

²⁹ MPEP 2143.

³⁰ *In re Vaeck*, 947 F.2d 488, 20 USPQ.2d 1438 (Fed. Cir. 1991). MPEP 2143.

Attorney Docket No. AOL0149

U.S. Serial No. 10/719,483

detail, Erlich and Edlund employ completely inconsistent approaches. Accordingly, since an ordinarily skilled artisan would not realize reasonable prospects of success in combining Erlich and Edlund, a *prima facie* case of obviousness is lacking.

Conclusion as to Claims 1-5, 7-12, 14-19, 21-26, 28-32

As shown above, then, these claims are patentable since a *prima facie* case of obviousness does not exist. Namely, (1) the applied art fails to teach the features of the claims, (2) there is insufficient motivation to combine/modify references as proposed by the office action, and (3) there is no showing that an ordinarily skilled artisan would have a reasonable expectation of success in making the office action's proposed modification of references.

35 USC 103 REJECTIONS
CLAIMS 6 & 20

These claims were rejected under 35 USC 103 as being unpatentable over the combination of Erlich, Edlund, and U.S. Patent Document 2003/0133076 to Lehmeier et al. ("Lehmeier"). Even without considering the individual merits of claims 6/20, they are patentably distinguished over the proposed combination because they depend from independent claims 1/15, which are allowable over Erlich/Edlund (as discussed above), and Lehmeier fails to provide the features missing from Erlich/Edlund. For instance, Lehmeier still does not show the claimed combination including features such as "the browser receiving..." or "the browser providing...." or "responsive to the browser receiving..." or "the browser displaying..." Indeed, the office action's reason for introducing Lehmeier was an attempt to show a different feature, namely a search cart in the form of a pull down or a side bar. [Office Action: page 11]

Accordingly, claims 6 and 20 are patentably distinguished from the applied art.

RECEIVED
CENTRAL FAX CENTER

Attorney Docket No. AOL0149

JAN 22 2007 U.S. Serial No. 10/719,483

**35 USC 103 REJECTIONS
CLAIMS 13 & 27**

These claims were rejected under 35 USC 103 as being unpatentable over the combination of Erlich, Edlund, and U.S. Patent No. 6,339,773 to Rishe. Even without considering the individual merits of claims 13/27, they are patentably distinguished over the proposed combination because they depend from independent claims 1/15, which are allowable over Erlich/Edlund (as discussed above), and Rishe fails to provide the features missing from Erlich/Edlund. For instance, Rishe still does not show the claimed combination including features such as "the browser receiving..." or "the browser providing...." or "responsive to the browser receiving..." or "the browser displaying..." Indeed, the office action's reason for introducing Rishe was an attempt to show a different feature, namely, "responsive to receiving user designation of selected entries within said search cart list, transferring said selected entries to a nonvolatile bookmarks list..." [Office Action: page 12]

Accordingly, claims 13 and 27 are patentably distinguished from the applied art.

CONCLUSION

In view of the foregoing, all pending claims in the application are patentable over the applied art.

//

//

//

//

//

//

//

//

//

//

Attorney Docket No. AOL0149

U.S. Serial No. 10/719,483

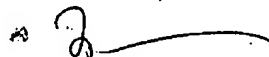
FEESRECEIVED
CENTRAL FAX CENTER

JAN 22 2007

Applicant does not believe that filing of this Amendment will incur additional fees. However, the Commissioner is authorized to charge any fees due and credit any overpayments to the Glenn Patent Group Deposit Account No. 07-1445, Customer No. 22862. Applicant considers this document to be filed in a timely manner

Should the Examiner have any questions concerning the Application, the Examiner is urged to contact Applicant's attorney at (650) 474-8400.

Respectfully submitted



Michael Glenn
Reg. No. 30,176

USPTO Customer 22,862